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Re: GOLF CLUB AND METHOD FOR MAKING IT
Appeal No. 2004-0234

MESSAGE: Please see attached.

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Kyriacos Tsircou, Esquire

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XX Appellants' Reply to Supplemental Examiner's Answer
XX Transmittal Form
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Applicants' Name: Joseph H. Hoffman et al.
Title: GOLF CLUB AND METHOD FOR MAKING IT
Serial No.: 09/881,361 Filing Date: 6/13/01
Examiner's Name: Stephen Luther Blau Group Art Unit: 3711
Our Docket No.: EKM-80279 Date Transmitted: 6/1/04
Client: Taylor Made Date Due: 5/31/04
Atty/Sec: Tsircou/Johnson

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**TRANSMITTAL LETTER
(General - Patent Pending)**Docket No.
0EKM-080279In Re Application Of: **Joseph H. Hoffman et al**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/881,361	6/13/2001	Stephen Luther Blau	30764	3711	

Title: **GOLF CLUB AND METHOD FOR MAKING IT**COMMISSIONER FOR PATENTS:

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Appellants' Reply to Supplemental Examiner's Answer**FAX RECEIVED****JUN 07 2004****GROUP 3700**

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Registration No. 53,705
Sheppard, Mullin, Richter & Hampton LLP
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REMARKS:

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 09/881,361
Applicants : Joseph H. Hoffman et al.
Filed : June 13, 2001
TC/A.U. : 3711
Examiner : Stephen Luther Blau
Docket No. : 0EKM-080279
Customer No. : 30764

Confirmation No. 8740
Appeal No: 2004-0234

APPELLANTS' REPLY TO SUPPLEMENTAL EXAMINER'S ANSWER

Board of Patent Appeals
and Interferences
U.S. Patent and Trademark Office
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Sirs:

This brief is submitted, pursuant to 37 C.F.R. § 1.193(b)(1), in reply to the Supplemental Examiner's Answer, mailed March 31, 2004, which provided a complete English translation of the Examiner primary prior art reference - Japanese Patent Document 9-248355 (Japan '355).

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I. DISCUSSION

A. The Supplemental Answer Restates the Failing of the Pending Rejections Previously Identified.

As noted on page 3, the Supplemental Answer substantially restates the rejections and supporting arguments submitted in the original Answer. The Examiner notes that the only

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changes to the rejections were with regard to citations of disclosed teachings. For example, as provided on page 4, the Examiner now cites to Japan '355 by paragraph numbers. Except for the addition of paragraph 18 on page 14, the remaining text appears to be a reprint of the original Answer, without reference to or consideration of Appellants' Reply Brief.

B. Japan '335 Fails to Even Suggest Appellants' Invention.

On page 14 of the Supplemental Answer, the Examiner asserts that the teaching in paragraph [0010] of Japan '355, "even more supplies motivation of using other suitable forms of weights to make the modifications that were made to Japanese Patent Document 9-248355."

Appellants respectfully disagree. Paragraph [0010] states, as follows:

"Weights 11 can be formed using an equivalent material alone or various materials by a combination when they are fixed. The following materials at the following specific gravities are also utilized other than the aforementioned materials: copper (8.93 specific gravity); iron (7.64 specific gravity); zinc (7.14 specific gravity); and titanium (4.5 specific gravity). Weights are not limited to the solid form, but can also be in a powder form such as tungsten powder or the like."

The Examiner fails to state forms of weights taught by Japan '355 would motivate a skilled artisan to further modify the golf club of Japan '355 to arrive at Applicants' invention. Paragraph [0010], referenced by the Examiner, does not even suggest Appellants' invention. The alleged motivation must be derived from a specific understanding in the prior art, such that a skilled artisan with no knowledge of the invention would be motivated to make the claimed invention. See In re Kotzab, 217 F.2d 1365, 1371 (Fed. Cir. 2000). Appellants' invention, as set forth in claim 1, for example, includes a hosel plug comprising a mixture of a metallic powder

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and a compliant polymeric material, in prescribed relative proportions, sized to fit snugly into the lower portion of the hosel cavity, where it is secured in place by compression of its compliant polymeric material. In contrast, the "forms of weights" taught by Japan '355 include: (1) solid weights formed of a selected material (e.g., lead, copper, titanium) (*see*, [0007], [0010]); (2) a combination of such solid weights "fixed" to each other (*see*, [0010]); and (3) a powder weight (*id.*). Additionally, Japan '355 only discloses the use of adhesives for securing the weights in place. Nowhere does Japan '355 suggest the use of weights comprising a prescribed mixture of a metallic powder and a compliant polymeric material sized to fit snugly into the lower portion of the hosel cavity and held in place by compression of its compliant polymeric material. Consequently, there is no motivation to modify the golf club of Japan '355 to arrive at Appellants' invention.

C. Japan '355 Teaches Against the Examiner's Proposed Modification.

Additionally, Japan '355 teaches against the Examiner's proposed modification. Specifically, the Examiner proposes replacing the weights of Japan '355 with weights described in Kochevar (U.S. Patent No. 4,220,336), weights having a putty-like consistency and a sticky, adherent quality. *See, e.g.*, col. 3, lines 25-50; col. 5, lines 51-56. Installation of Kochevar's weights includes causing its sticky mass (13) of the weights to adhere to adjacent structure. Col. 4, lines 24-56. Consequentially, the Examiner's proposed modification likely result in a portion of the sticky mass to adhere to the tip of the club shaft. However, Japan '355 specifically teaches against material interfering with the tip of the club shaft *See* [0002] - [0005]. Given the

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teachings of Japan '355, a skilled artisan would have been deterred from making the Examiner's proposed modification to Japan '355.

For these reasons alone, the pending obviousness rejections are improper.
Appellants respectfully urge the Board to reverse these rejections.

II. Conclusion

For the reasons stated in Appellants' Brief and Appellants' Reply Brief, supplemented by the reasons set forth above, the rejections under appeal are improper and should be reversed. A decision directing the Examiner to issue a Notice of Allowance is respectfully requested.

Date: June 1, 2004

Respectfully Submitted,

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By: 

Kyriacos Tsircou

Registration No. 53,705

333 South Hope Street, 48th Floor
Los Angeles, California 90071
Telephone: (213) 620-1780
Facsimile: (213) 620-1398